

U. S. Application No. 09/584,966

**REMARKS****INTRODUCTION**

In accordance with the foregoing, claims 1, 4, 5, and 9 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 2, 4, 5, and 9-14 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §103****Claims 1, 2, 4, 5, 9, 11, 13, and 14**

In the Office Action at pages 2-7, claims 1, 2, 4, 5, 9, 11, 13, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,486,686 to Zdybel, Jr., et al. in view of R. Adams "BarCode1 web site" (hereinafter "BarCode1"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

The present invention is directed to article allocation for an information medium, such as a newspaper, which has only limited space available in which to insert allocated information. More specifically, amended independent claim 1 is directed to "[A] method of producing printed matter containing a direct-reading material and an additional material related to the direct-reading material by an information processing apparatus, the direct-reading material comprising text and pictures, and the additional material comprising text, sound, and images related to the direct-reading material." In relevant part, amended independent claim 1 recites "converting primary data of the additional material into secondary data in the form of codes for high-density display," "storing data to be applied to an allocating operation," and "determining a specific way of allocating the additional material with respect to relevant direct-reading material based on the stored data," and "performing the allocating operation for the direct-reading material and the additional material in accordance with a type space corresponding to the secondary data." Independent claims 4 and 9 have been amended to recite similar features. Support for these amendments to claims 1, 4, and 9 can be found in the originally filed specification, at least in Figs. 12, 13, and 15 and at page 23, line 30 to page 25, line 31.

Applicant has previously asserted that neither Zdybel, Jr., et al. nor BarCode1 teach or suggest a "specific way of allocating the additional material with respect to the relevant direct-reading material is selected from among the following ways of allocating the additional material: allocating at an immediate position of the relevant direct-reading material, allocating at a special space, allocating at a directly designated vacant position, or allocating at a directly designated

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overlapping position," as recited in the amended independent claims. Applicant notes that BarCode1 has been relied upon only to teach "the direct-reading material comprising text and pictures, and the additional material comprising text, sound, and images related to the direct-reading material."

At page 8, in numbered item 8, the outstanding Office Action asserts that Zdybel, Jr., et al. teaches "that the glyphs may be printed at various locations on the hardcopy document (102)." Further, the Office Action cites col. 9, lines 13-21 of Zdybel, Jr., et al., which states "For instance, one or more fields may be set aside in the top, bottom right-hand, or left-hand margins of the document (102) for the printing of such glyphs, as shown in Figs. 3 and 4, the glyphs may be printed in machine identifiable glyph frames which are fully or partially confined within the margins of the human readable field of the document (102) or fully outside those margins." The Office Action asserts that this portion of Zdybel, Jr., et al. suggests the claimed limitation of "allocating at a directly designated vacant position in that fields may be set aside, or allocated in different locations for the location and display/printing of glyphs that relate to the printed matter." Applicant respectfully disagrees with the Examiner's assertion.

Applicant submits that col. 9, lines 13-21 of Zdybel, Jr., et al. teaches only that some sort of layout of glyphs may be permitted. Further, Zdybel, Jr., et al. at col. 9, lines 53-56 states that "the appearance related data that may be recovered at 121 includes the ASCII text bits as at 123, the font style bits as at 124, and the page layout data as at 124." Thus, Zdybel, Jr., et al. merely teaches that page layout data is included in the glyphs

The present invention, in contrast to Zdybel, Jr., et al. and BarCode1, now recites "storing data to be applied to an allocating operation" in amended independent claims 1 and 9. Independent claim 4 has been similarly amended to include "a database storing data to be applied to an allocating operation." In a non-limiting example, the data stored to be applied to an allocating operation may be conditional data applied to an allocating operation. Applicant respectfully submits that neither Zdybel, Jr., et al. nor BarCode1 teaches or suggests these features as recited in amended independent claims 1, 4, and 9.

Further, independent claims 1 and 9 have been amended to recite "determining a specific way of allocating the additional material with respect to relevant direct-reading material based on the stored data." Independent claim 4 has been similarly amended to recite "a determining part configured to determine a specific way of allocating the additional material with respect to relevant direct-reading material, based on the data stored in said database." In a non-limiting example, according to the present invention, as shown in Fig. 15, the layout design mechanism 14 (shown in Fig. 1) automatically carries out the layout design based on the

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conditional data stored in database 24. Thus, the present invention may free a user from involvement in complicated layout design work, and may provide improved efficiency for layout design work by appropriately allocating additional material while minimizing user involvement. Applicant respectfully submits that neither Zdybel, Jr., et al. nor BarCode1 teaches or suggests this feature of the present invention.

In view of the amendments made to independent claims 1, 4, and 9, Applicant respectfully asserts that BarCode1 fails to cure the deficiencies of Zdybel, Jr., et al. with respect to independent claims 1, 4, and 9, and claims 2, 5, 11, 13, and 14, which depend directly or indirectly therefrom. Thus, Zdybel, Jr., et al. and BarCode1, whether taken individually or in combination, fail to teach or suggest all of the features of independent claims 1, 4, and 9. For at least the reasons set forth above, Applicant respectfully submits that amended independent claims 1, 4, and 9, and those claims depending directly or indirectly therefrom, patentably distinguish over the prior art and are in condition for allowance.

#### Claims 10 and 12

In the Office Action at pages 7-8, numbered item 7, dependent claims 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Zdybel, Jr., et al. in view of BarCode1, and further in view of U.S. Patent No. 5,938,727 to Ikeda. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Dependent claims 10 and 12 depend indirectly from amended independent claims 1 and 4, respectively. As discussed above with respect to amended independent claims 1 and 4, Applicant respectfully submits that BarCode1 fails to cure the deficiencies of Zdybel, Jr., et al. Ikeda is relied upon only to teach "said linking the direct-reading material and the related additional material uses an address of a separate storage location in which said related additional material is stored." Applicant respectfully submits that Ikeda fails to cure the deficiencies of Zdybel, Jr., et al. and BarCode1 noted above. Thus, Applicant respectfully submits that Zdybel, Jr., et al., BarCode1, and Ikeda, whether taken individually or in combination, fail to teach or suggest all of the features of dependent claims 10 and 12. Accordingly, Applicant submits that claims 10 and 12 patentably distinguish over the prior art for at least the same reasons as claims 1 and 4, from which the indirectly depend and, therefore, are in condition for allowance.

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**CONCLUSION**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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